APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/585,460	06/01/2000	Jonathan Strietzel	252/173	3051

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EXAMINER
NGUYEN, QUYNH H

ART UNIT	PAPER NUMBER
2642	

DATE MAILED: 11/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/585,460	STRIETZEL, JONATHAN
	Examiner	Art Unit	
	Quynh H. Nguyen	2642	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>*remarks filed 8/26/05*</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *13,33-50,57-66 and 76-83* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *13,33-50,57-66 and 76-83* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   The text of those sections of Title 35, U.S. Code not included in this action can

be found in a prior Office action.

Response to Amendment

2.   Applicant's amendment filed on August 26, 2005 has been entered. No claims

have been amended. No claims have been cancelled. No claims have been added.

Claims 13, 33-50, 57-66, and 76-83 are still pending in this application, with claims 13,

76, and 83 being independent.

Claim Objections

3.   Claim 34 is objected to because of the following informalities: line 2 recites

"configured to associated..." should be -- configured to associate... --. Appropriate

correction is required.

Claim Rejections - 35 USC § 112

4.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making
> and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it
> pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode
> contemplated by the inventor of carrying out his invention.

Claim 33 recites, "replace a dial tone that would normally be routed to the

source". Does this mean that when one first picks up the phone, hears a dial tone and

has not yet dial a destination yet, would hear advertisement instead of a dial tone. It is

not understood as what advertisement would be playing to the destination since the

destination is unknown? And when will the caller dial the destination? Does the caller

dial the destination while the advertisement is playing?

5.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 recites "subscriber", "third party", "user", "communication source", and

"destination". It is unclear as to what relationship between these parties. Claim 1

recites all these above parties and there is no tied between one party and another party.

For example, if a user is a calling party and speaks Spanish language, is the processor

configured to selectively <u>associate</u> advertisement in Spanish? It is also unclear whose

language? Whose geography? Is it the language or geography of the calling party or

called party?

Claims 57, 76 and 83 have the same defect.

Claim Rejections - 35 USC § 103

6.   Claims 13, 33-43, 49-50, 57-59, 65-66, 76-77, and 83 are rejected under 35

U.S.C. 103(a) as being unpatentable over Carrier et al. (U.S. Patent 5,195,126) in view

of Gregorek et al. (U.S. Patent 5,557,658).

Regarding claim 13, Carrier et al. teach an emergency alert database (abstract,

lines 13-17 - "second storage") that stores subscriber specific ("personalized message");

and a processing means coupled with the database configured to selectively associate

with a destination of an incoming communication and places a call to a series of

destination subscriber stations with a personalized message indicating that there is a

potential emergency situation (abstract, lines 17-20 and col. 2, lines 42-45 and col. 4,

lines 49-53).

Carrier et al. do not teach selecting at least one advertisement in the

advertisement database from a group consisting of user preferences, language,

communication source, communication type, time of day, communication destination,

and geography.

Gregorek teaches an advertisement database (Fig. 4, 60) that stores subscriber

specific ("customized menu"); and a processing mean ("message generator") configured

to selectively associate, based on one or more factors selected from the group

consisting of user preferences ("customized menu selection"), time of day (col. 9, lines

5-10), communication source ("the network address of the first telephone 12 or other

device") and geography (col. 9, lines 17-28 and col. 19, lines 53-60), communication

types (col. 6, lines 22-26), communication destination ("services provided by a particular

corporation or individual" - col. 14, lines 53-54).

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify Carrier's emergency alert system to couple a processor

with the advertisement database, and to route the associated advertisement to the

destination. It would be beneficial to be able to productively occupy the time when both

the calling and called parties are on the line, and to avoid both parties to listen to a

meaningless or annoying busy signal, a ringback signal, or wait idly while one of the

parties station receives another call or processes information.

Regarding claims 33, 35, and 36, Gregorek teaches the processing means is configured to cause the advertisement associated with the source to replace a dial tone that would normally be routed to the source, to be routed to the source prior to connecting the source with the destination, and just prior to a dial tone being routed to the source (col. 3, lines 48-56).

Regarding claim 34, Gregorek teaches the processing means is configured to cause the advertisement associated with the source to replace the rings of a ring back signal that would normally be routed to the source (col. 8, line 61 through col. 9, line 4).

Regarding claims 37 and 58, Carrier et al. teach the processing means is configured to selectively associate with the destination with a personalized message indicating that there is a potential emergency situation (abstract, lines 17-20 and col. 2, lines 42-45 and col. 4, lines 49-53). Carrier et al. do not teach the advertisement associated with the destination when the destination does off hook. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Carrier's emergency alert system to alert or route advertisement information when the destination goes off hook in order to have a two ways routing advertisement system.

Claim 38 is rejected for the same reasons as discussed above with respect to claim 13. Furthermore, Gregorek teaches the advertisement associated with the source to be routed to the source (col. 9, lines 5-7).

Regarding claim 39, Gregorek teaches the message generator determines the duration in which the announcements are to be played (col. 11, lines 29-31). However, Gregorek does not teach the advertisement associated with the source and the

advertisement associated with the destination last the same amount of time. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the feature mentioned above to Gregorek's system in order to stop the advertisements at the source and the destination at the same time when call processing is established.

Regarding claims 40 and 41, Gregorek teaches (Fig. 1) a switching center 15 interfaced with the source and the processing means comprises part of the switching center and a router to route the incoming call from the source 12 to the destinations 20 and 28.

Regarding claims 42, 43, and 59, Gregorek teaches the database (Fig. 2, 102) configured to store the user preferences (col. 9, lines 55-61).

Regarding claims 49 and 65, Gregorek teaches the user can access the database to update their user preferences (col. 10, lines 61-65 and col. 19, line 61 through col. 20, line 3).

Regarding claims 50 and 66, Gregorek teaches the database is interfaced with the Internet, and wherein the user can access the database to update the user preferences via the Internet (col. 19, lines 28-30 - *other device*).

Claims 57 and 77 are rejected for the same reasons as discussed above with respect to claim 13. Furthermore, Gregorek teaches at least one advertisement in the advertisement database with the source of an incoming communication (col. 19, lines 53-60).

Claims 76 and 83 are rejected for the same reasons as discussed above with respect to claims 13, 34, and 57.

7.   Claims 44-48, 60-64, and 78-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carrier et al. (U.S. Patent 5,195,126) in view of Gregorek et al. (U.S. Patent 5,557,658) and further in view of Kung et al. (U.S. Patent 6,373,817).

Regarding claims 44-48, 60-64, and 78-82, Gregorek teaches the users preferences can be of any particular subject matter (col. 14, lines 50-57). However, Gregorek does not teach the user preferences include the user's age, salary, gender, marital and economic status, political affiliation, and number of children.

Kung et al. teach the announcement server 220 may be utilized to track the user's age, salary ("income") (col. 10, lines 13-20).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the features of the user preferences include the user's age, salary, marital status, and number of children in Gregorek's system in order to customize and play the appropriate advertisement to both the calling and called parties.

Response to Arguments

8.   Applicant's arguments filed 8/26/05 have been fully considered but are not persuasive. Applicant's arguments are addressed in the above claims rejections.

Applicant mainly argues that:

In Carrier, "these other destination dialed by the system are not a destination as defined in the present application and claimed in claim 13, because these destination are not the destination of the incoming communication, which is processed normally". The argument is vague. It is unclear how a destination is defined in claim 13 or in the present application? It is not understood what is the destination of the incoming communication which is processed normally?

Gregorek does not teach very short advertisement can be used in place of the rings of the ringback signal, but rather replacing the entire ringback signal with a continuous advertisement. Examiner respectfully submits that this is not detailing recited in the claims. All ringback signal are short, therefore advertisements in place of the ringback signal are short also.

9.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quynh H. Nguyen whose telephone number is 571-272-7489. The examiner can normally be reached on Monday - Thursday from 6:15 A.M. to 4:45 P.M.
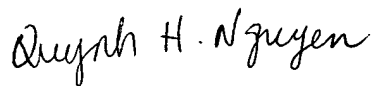
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on 571-272-7488. The fax phone number for the organization where this application or proceeding is assigned is 572-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Quynh H. Nguyen
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Art Unit 2642